

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 8,071,092

Patent Application No. 09/589,288

Confirmation No. 1519

Applicant: Yu et al.

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Examiner: Bridget E. Bunner

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Commissioner for Patents
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**APPLICATION FOR PATENT TERM ADJUSTMENT (37 C.F.R. § 1.705(d))
AND
STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT AND BASIS
THEREFOR UNDER 37 C.F.R. § 1.702**

Sir:

Pursuant to 37 C.F.R. § 1.705(d), Applicants request reconsideration of the patent term adjustment reflected on the front page of U.S. Patent 8,071,092, which issued on December 6, 2012. This request is being timely filed within two months of the date the patent issued, as required by 37 C.F.R. § 1.705(d).

This request raises one issue that previously was raised in the Application for Patent Term Adjustment Pursuant to 37 C.F.R. § 1.705(b) filed on October 25, 2011. On November 4, 2011, the United States Patent and Trademark Office (USPTO) mailed a petition decision dismissing Applicants' Application for Patent Term Adjustment Pursuant to 37 C.F.R. § 1.705(b) as premature. In particular, the USPTO required Applicants to "wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d)." (See page 2, first paragraph, of the Decision on Request for Reconsideration of Patent Term Adjustment mailed November 4, 2011.)

Accordingly, this request does not raise any issue that could have been raised during the pendency of the application that issued as the referenced patent.

In accordance with 37 C.F.R. § 1.705(b)(1), Applicants submit herewith the appropriate fee pursuant to 37 C.F.R. § 1.18(e) (\$200.00).

The requirements of 37 C.F.R. § 1.705(b)(2) are satisfied by the following Statement of Facts:

1. The application that issued as the referenced patent, U.S. Patent Application No. 09/589,288 (hereinafter “the ‘288 application”), was filed on June 8, 2000, and, therefore, the referenced patent is eligible for patent term adjustment under 35 U.S.C. § 154.
2. The patent term adjustment as calculated by the USPTO (and as reflected on the front of the referenced patent) is 1597 days. This patent term adjustment, as determined by the USPTO, represents the combination of (1) the examination delay of 1677 days by the USPTO under 37 C.F.R. §§ 1.702(a) and 1.703(a) (referred to by the Office as “A Delays”), (2) the examination delay of 430 days by the USPTO under 37 C.F.R. §§ 1.702(b) and 1.703(b) (referred to by the Office as “B Delays”), (3) the examination delay of 763 days by the USPTO under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e) (referred to by the Office as “C Delays”), minus 824 overlapping days between the “A and B” delays and between the “A and C” delays, minus 449 days of Applicant delay under 37 C.F.R. § 1.704 (i.e., $(1677 + 430 + 763) - 824 - 449 = 1597$).
3. Correction of the patent term adjustment is sought to correctly account for the period of A delay by the USPTO under 37 C.F.R. §§ 1.702(a) and 1.703(a) and for the period of B delay by the USPTO under 37 C.F.R. §§ 1.702(b) and 1.703(b).
4. The USPTO’s patent term adjustment calculation indicates that the total A delay is 1677 days.
5. A Notice of Allowance was mailed in the ‘288 application on July 27, 2009.

6. An issue fee transmittal, together with the payment of the appropriate issue fee, was filed in the '288 application on October 22, 2009, which is within three months of the July 27, 2009 mailing date of the Notice of Allowance.

7. An Issue Notification was mailed in the '288 application on September 15, 2010, indicating a projected patent issue date of October 5, 2010.

8. Pursuant to 37 C.F.R. § 1.703(a)(6), the period of patent term adjustment due to examination delay includes the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

9. The issue fee transmittal, together with the payment of the appropriate issue fee, was filed in the '288 application on October 22, 2009, thereby satisfying the requirements under 37 C.F.R. § 1.703(a)(6) on October 22, 2009.

10. A petition to withdraw the '288 application from issue, together with a Request for Continued Examination, was filed on September 23, 2010. As such, Applicants ended the period of adjustment under 37 C.F.R. § 1.703(a)(6) on September 23, 2010, prior to issuance of the patent.

11. Pursuant to 37 C.F.R. § 1.703(a)(6), the term of the referenced patent should be adjusted for the period beginning on February 23, 2010 (the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied) and ending on September 23, 2010 (the date Applicants filed a petition to withdraw the patent from issue, thereby ending the period of adjustment under 37 C.F.R. § 1.703(a)(6)), which is a period of 213 days.

12. In calculating only 1677 days of patent term adjustment for the period of A delay, the USPTO failed to correctly calculate the period of A delay, as required by 37 C.F.R. §§ 1.702(a) and 1.703(a). Specifically, the USPTO failed to include the period of examination delay by the USPTO under 37 C.F.R. § 1.703(a)(6), which is a period of 213 days, in the A delay calculation. Therefore, the correct period of A delay is 1890 days (i.e., 1677 days + 213 days).

13. The USPTO's patent term adjustment calculation indicates that the total B delay is 430 days.

14. A Notice of Appeal was filed in the '288 application on February 12, 2003.

15. In response to the Notice of Appeal, an Office Action was mailed on June 3, 2003.

16. In accordance with 37 C.F.R. § 1.703(b)(4), the USPTO's patent term adjustment calculation includes a reduction in the period of B delay of 112 days for the period beginning on February 12, 2003, the date on which a Notice of Appeal was filed, and ending on June 3, 2003, the date of mailing of an action under 35 U.S.C. § 132.

17. The USPTO issued a Notice of Proposed Rule Making on December 28, 2011, in which the USPTO proposes to change the rules of practice to indicate that the period of appellate review under the patent term adjustment provisions of 35 U.S.C. § 154(b)(1)(B) begins when jurisdiction over the application passes to the BPAI, rather than the date on which a Notice of Appeal to the BPAI is filed. Proposed Rules, 76 Fed. Reg. 81432, 81437 (Dec. 28, 2011).

18. The Notice of Proposed Rule Making states, *inter alia*, that the USPTO is proposing to amend 37 C.F.R. § 1.703(b)(4) to define the period of delay "as the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the BPAI under § 41.35 of this title and ending on the date of a final decision in favor of the applicant by the BPAI or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145." Proposed Rules, 76 Fed. Reg. at 81435.

19. The period of delay calculated under 37 C.F.R. § 1.703(b)(4) for the referenced patent should be 0 days because the filing of the Notice of Appeal did not result in jurisdiction over the application passing to the BPAI. Accordingly, the patent term adjustment calculation for the referenced patent would *not* include a reduction in the period of B delay of 112 days, thereby increasing the period of B delay by 112 days.

20. Correction of the patent term adjustment is sought to correctly account for the period of B delay, which constitutes a total of at least 542 days (i.e., 430 days + 112 days) if the period of B delay is calculated from the period beginning on June 9, 2003, the day after

the date that is three years after the date on which the '288 application was filed, and ending on December 1, 2004, the day before the date on which a first Request for Continued Examination was filed.

21. The USPTO's calculation of the period of B delay includes a reduction for the period from December 2, 2004, the date on which a first Request for Continued Examination was filed, through December 6, 2011, the date the patent issued, which constitutes a total of 2561 days.

22. Correction of the patent term adjustment is sought to correctly account for the period of B delay from June 9, 2003, the day after the date that is three years after the date on which the '288 application was filed, through December 6, 2011, the date the referenced patent issued, which constitutes a total of 3103 days, but not including the period from August 15, 2006, the date an interference was declared to involve the '288 application, through September 15, 2008, the date that the USPTO has calculated as the termination date of the interference involving the '288 application, which constitutes a total of 763 days. Thus, the correct period of B delay is 2340 days (i.e., 3103 days - 763 days).

23. The USPTO's patent term adjustment calculation indicates that the total C delay is 763 days.

24. When the period of B delay is corrected to include the period from the day after the date that is three years after the date on which the '288 application was filed (i.e., June 9, 2003) through the date the referenced patent issued (i.e., December 6, 2011), the entire period of A delay (i.e., 1890 days) overlaps with either B or C delay, such that the total number of overlapping days between the A and B delays and the A and C delays is 1890 days.

25. Alternatively, when the period of B delay includes a reduction for the period from December 2, 2004, the date on which a first Request for Continued Examination was filed, through December 6, 2011, the date the patent issued, 62 days of A delay overlap with B delay, and 763 days of A delay overlap with C delay, such that the total number of overlapping days between the A and B delays and the A and C delays is 825 days.

26. The USPTO's patent term adjustment calculation indicates that the total Applicant delay under 37 C.F.R. § 1.704 is 449 days.

27. The USPTO's patent term adjustment calculation indicates an Applicant delay of 92 days from May 21, 2001, the day after the date that is three months after the date of mailing of a Restriction Requirement, through August 20, 2001, on which date a Reply to Restriction Requirement was filed by Applicants.

28. The USPTO's patent term adjustment calculation indicates an Applicant delay of 86 days from February 7, 2002, the day after the date that is three months after the date of mailing of an Office Action, through May 3, 2002, on which date a Reply to Office Action was filed by Applicants.

29. The USPTO's patent term adjustment calculation indicates an Applicant delay of 91 days from November 14, 2002, the day after the date that is three months after the date of mailing of an Office Action, through February 12, 2003, on which date a Notice of Appeal was filed by Applicants.

30. The USPTO's patent term adjustment calculation indicates an Applicant delay of 90 days from September 4, 2003, the day after the date that is three months after the date of mailing of an Office Action, through December 2, 2003, on which date a Reply to Office Action was filed by Applicants.

31. The USPTO's patent term adjustment calculation indicates an Applicant delay of 90 days from September 4, 2004, the day after the date that is three months after the date of mailing of an Office Action, through December 2, 2004, on which date a Request for Continued Examination was filed by Applicants.

32. Other than the circumstances described above, there have been no circumstances that could reasonably be construed as a failure to engage in reasonable efforts to conclude processing or examination of this application.

33. When the period of B delay is corrected to include the period from the day after the date that is three years after the date on which the '288 application was filed (i.e., June 9, 2003) through the date the referenced patent issued (i.e., December 6, 2011), the correct

patent term adjustment is 2654 days. The correct patent term adjustment represents the combination of (1) the examination delay of 1890 days by the USPTO under 37 C.F.R. §§ 1.702(a) and 1.703(a), (2) the examination delay of 2340 days by the USPTO under 37 C.F.R. §§ 1.702(b) and 1.703(b), (3) the examination delay of 763 days by the USPTO under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e), minus 1890 overlapping days between the A and B delays and the A and C delays, minus 449 days of Applicant delay under 37 C.F.R. § 1.704 (i.e., $(1890 + 2340 + 763) - 1890 - 449 = 2654$).

34. Alternatively, when the period of B delay includes a reduction for the period from December 2, 2004, the date on which a first Request for Continued Examination was filed, through December 6, 2011, the date the patent issued, the correct patent term adjustment is 1921 days. The correct patent term adjustment represents the combination of (1) the examination delay of 1890 days by the USPTO under 37 C.F.R. §§ 1.702(a) and 1.703(a), (2) the examination delay of 542 days by the USPTO under 37 C.F.R. §§ 1.702(b) and 1.703(b), (3) the examination delay of 763 days by the USPTO under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e), minus 825 overlapping days between the A and B delays and the A and C delays, minus 449 days of Applicant delay under 37 C.F.R. § 1.704 (i.e., $(1890 + 542 + 763) - 825 - 449 = 1921$).

35. The referenced patent is subject to a terminal disclaimer based on the expiration date of the full statutory term of U.S. Patent 7,879,328. The face of U.S. Patent 7,879,328 indicates that it is entitled to 762 days of patent term adjustment.

Applicants do not contest the USPTO's calculation of the total C delay under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e) or the USPTO's calculation of the period of Applicant delay.

In view of the facts set forth above, Applicants respectfully request that the USPTO's calculation of the total A delay under 37 C.F.R. §§ 1.702(a) and 1.703(a) and the total B delay under 37 C.F.R. §§ 1.702(a) and 1.703(a) be reconsidered and corrected. Applicants set forth the following reasons for the requested correction of the patent term adjustment:

Requested Correction of A Delay

Under 35 U.S.C. § 154(a)(2), a patentee is entitled to a patent term of 20 years from the date of filing. Section 154(b)(1)(A) guarantees extensions of patent term for each day the USPTO delays in responding to certain patentee filings (“A delay”). In particular, Section 154(b)(1)(A) reads as follows:

GUARANTEE OF PROMPT PATENT AND TRADEMARK
OFFICE RESPONSES.- Subject to the limitations under paragraph
(2), if the issue of an original patent is delayed due to the failure of
the Patent and Trademark Office to-

(i) provide at least one of the notifications under section 132 of
this title or a notice of allowance under section 151 of this title not
later than 14 months after-

the date on which an application was filed under section 111(a)
of this title; or

the date on which an international application fulfilled the
requirements of section 371 of this title;

(ii) respond to a reply under section 132, or to an appeal taken
under section 134, within 4 months after the date on which the
reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a
decision by the Board of Patent Appeals and Interferences under
section 134 or 135 or a decision by a Federal court under section
141, 145, or 146 in a case in which allowable claims remain in the
application; or

(iv) issue a patent within 4 months after the date on which the
issue fee was paid under section 151 and all outstanding
requirements were satisfied, the term of the patent shall be
extended 1 day for each day after the end of the period specified in
clause (i), (ii), (iii), or (iv), as the case may be, until the action
described in such clause is taken.

Thus, if the issue of a patent is delayed due to the failure of the United States Patent and Trademark Office to “*issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied,*” the term of the patent shall be extended 1 day for each day after the end of the specified period until the described action is taken. 35 U.S.C. § 154(b)(1)(A) (emphasis added).

In providing for the implementation of 35 U.S.C. § 154(b)(1)(A), the USPTO has promulgated 37 C.F.R. § 1.702(a), which generally tracks the language of 35 U.S.C. § 154(b)(1)(A). The USPTO also has promulgated 37 C.F.R. § 1.703(a), which explains the manner of calculating the patent term adjustment period identified in 37 C.F.R. § 1.702(a) (i.e., Rule 703(a) explains how to calculate the A delay identified in Rule 702(a)). The relevant portion of 37 C.F.R. § 1.703(a) reads as follows:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods: ...

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

37 C.F.R. § 1.703(a). Thus, it is clear from both 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.703(a)(6) that the failure of the USPTO to issue a patent within four months from the date the issue fee was paid and all outstanding requirements were satisfied constitutes a period of delay by the USPTO. Both 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.703(a)(6) also make it clear that, in order to offset the delay caused by the failure of the USPTO to take action within four months from the date the issue fee was paid and all outstanding requirements were satisfied, the applicant shall be awarded 1 day of patent term adjustment for each day that the USPTO delayed the issuance of the patent.

As set forth in the statement of facts above, an issue fee transmittal, together with the payment of the appropriate issue fee, was filed in the ‘288 application on October 22, 2009. At the time the issue fee was paid, no further action was required by Applicants (i.e., all outstanding requirements were satisfied), as evidenced by the subsequent entry in the

USPTO's patent application information retrieval (PAIR) database on October 28, 2009, stating "Application Is Considered Ready for Issue." However, despite the USPTO's indication that the patent was ready for issue less than one week after the payment of the issue fee (i.e., on October 28, 2009), the USPTO failed to issue a patent within four months from the date the issue was paid and all outstanding requirements were satisfied. Thus, in accordance with the provisions of 35 U.S.C. § 154(b)(1)(A), Applicants are entitled to 1 day of patent term adjustment for each day that the USPTO delayed the issuance of the patent.

As discussed above, 37 C.F.R. § 1.703(a) has been promulgated by the USPTO in order to explain how to calculate the periods of delay provided for under 35 U.S.C. § 154(b)(1)(A). Under typical circumstances, the period of USPTO delay caused by the failure of the USPTO to issue a patent within four months of the payment of the issue fee is calculated as described in 37 C.F.R. § 1.703(a)(6) (i.e., the period is calculated from the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued). However, 37 C.F.R. § 1.703(a) fails to provide explicit guidance on how to calculate the period of USPTO delay caused by the failure of the USPTO to issue a patent within four months of the payment of the issue fee in situations in which the period does not end on the date the patent was issued.

In the present case, a petition to withdraw the '288 application from issue, together with a Request for Continued Examination, was filed on September 23, 2010 (i.e., prior to issuance of the patent). As such, Applicants terminated the period of USPTO delay on September 23, 2010 (i.e., prior to issuance of the patent). The mere fact that Applicants terminated the period of USPTO delay prior to issuance of the patent does not change the fact that the USPTO delayed the issuance of the referenced patent by failing to take action within four months of the payment of the issue fee. Accordingly, as provided for in 35 U.S.C. § 154(b)(1)(A), Applicants are entitled to 1 day of patent term adjustment for each day in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied that the USPTO delayed the issuance of the patent.

In view of the foregoing, the USPTO's calculation of the period of USPTO delay under 37 C.F.R. §§ 1.702(a) and 1.703(a) should be corrected to include the period beginning

on February 23, 2010 (the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied) and ending on September 23, 2010 (the date Applicants filed a petition to withdraw the patent from issue), which constitutes a period of 213 days. The correction of the USPTO's patent term adjustment calculation to include the period of delay provided for by 35 U.S.C. § 154(b)(1)(A) results in a total period of A delay under 37 C.F.R. §§ 1.702(a) and 1.703(a) of 1890 days (i.e., 1677 days + 213 days).

Improper Reduction in B Delay based on RCE

In addition to the extensions of patent term described in 35 U.S.C. § 154(b)(1)(A), patent term adjustment is guaranteed for every day a patent is pending after three years from the filing date under Section 154(b)(1)(B) ("B delay"). In particular, Section 154(b)(1)(B) reads as follows:

GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY. Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Thus, if the issue of a patent is “delayed due to the failure of the United States Patent and Trademark Office *to issue a patent within 3 years after the actual filing date* of the application in the United States not including ... any time consumed by continued examination of the application requested by the applicant under section 132(b) ... *the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.*” 35 U.S.C. § 154(b)(1)(B) (emphasis added).

Similar to the above discussion of 35 U.S.C. § 154(b)(1)(A), in providing for the implementation of 35 U.S.C. § 154(b)(1)(B), the USPTO has promulgated 37 C.F.R. § 1.702(b), which generally tracks the language of 35 U.S.C. § 154(b)(1)(B), as well as 37 C.F.R. § 1.703(b), which explains the manner of calculating the patent term adjustment period identified in 37 C.F.R. § 1.702(b) (i.e., Rule 703(b) explains how to calculate the “B delay” identified in Rule 702(b)). However, 37 C.F.R. § 1.703(b) is in conflict with 35 U.S.C. § 154(b)(1)(B). In particular, unlike 35 U.S.C. § 154(b)(1)(B), 37 C.F.R. § 1.703(b) indicates that the period of time after the filing of a Request for Continued Examination (“RCE”) is not to be considered in calculating the patent term adjustment under 37 C.F.R. § 1.702(b). The relevant portion of 37 C.F.R. § 1.703(b) reads as follows:

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, *but not including* the sum of the following periods:

(1) The number of days, if any, in *the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued*

37 C.F.R. § 1.703(b) (emphasis added). Thus, while the determination of patent term adjustment is controlled by 35 U.S.C. § 154, which contains no such exclusion of the time

period from the filing of an RCE until the issue of the patent for purposes of calculating the patent term adjustment, 37 C.F.R. § 1.703(b) cuts off the patent term adjustment period under 35 U.S.C. § 154(b)(1)(B) with the filing of an RCE.

Applicants submit that 37 C.F.R. § 1.703(b) should not control the determination of the patent term adjustment under 35 U.S.C. § 154(b)(1)(B) to the extent that the provisions of 37 C.F.R. § 1.703(b) conflict with the provisions of 35 U.S.C. § 154(b)(1)(B). As a result of the USPTO's having followed the provisions of 37 C.F.R. § 1.703(b) in conflict with the provisions of 35 U.S.C. § 154(b)(1)(B), Applicants were not granted the correct patent term adjustment. More specifically, the USPTO failed to correctly calculate the patent term adjustment under 35 U.S.C. § 154(b)(1)(B) (i.e., the B delay period) by excluding from the patent term adjustment the period of time from the filing of a first RCE during the prosecution of the patent application underlying the referenced patent and ending on the day of issue of the patent (i.e., by cutting off the B delay period with the filing of the RCE).

The patent application underlying the referenced patent was filed on June 8, 2000. The 3-year anniversary of the filing of patent application was June 8, 2003. A first RCE was not filed during this 3-year pendency, but rather was filed on December 2, 2004. Thus, since the USPTO failed to issue a patent within 3 years after the actual filing date of the application, and the 3-year period following the filing of the application did not include any time consumed by continued examination of the application requested by the applicant under section 132(b), Applicants are entitled to an extension of the patent term by 1 day for each day after the end of that 3-year period until the patent is issued under the provisions of 35 U.S.C. § 154(b)(1)(B).

The referenced patent issued on December 6, 2011. In the USPTO's current calculation of the period of B delay, the USPTO subtracted the period of time from the filing of the first RCE on December 2, 2004 and ending on the patent issuance date, December 6, 2011 [which is a time period of 2561 days] from the period of time from one day after the 3-year pendency anniversary (i.e., from June 9, 2003) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 3103 days].

If the USPTO had adhered to the provisions of 35 U.S.C. § 154(b)(1)(B), then there would have been no such subtraction from the period of time from one day after the 3-year pendency anniversary (i.e., from June 9, 2003) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 3103 days] of the period of time from the filing of the first RCE (i.e., from December 2, 2004) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 2561 days].

In the event that the USPTO disagrees with the position of Applicants that the period of B delay should include the period from the day after the date that is three years after the date on which the '288 application was filed (i.e., June 9, 2003), through the date the referenced patent issued (i.e., December 6, 2011) [which is a time period of 3103 days], and without waiver of the position of Applicants that the period of B delay should include the aforementioned 3103 day period, Applicants note that the period of B delay should at least include the period of time from one day after the 3-year pendency anniversary (i.e., from June 9, 2003) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 3103 days] *minus* the period(s) of time from the filing of the RCE until the mailing of the Notice of Allowance for the following reasons.

As discussed above, the provisions of 35 U.S.C. § 154(b)(1)(B) are tracked in 37 C.F.R. § 1.702(b), which indicates that “[a]ny delay in the processing of the application by the Office that was requested by the applicant” is not to be included in the consideration of the 3-year pendency guarantee. The USPTO apparently believes that the period of time from the filing of an RCE and ending on the patent issuance date constitutes a delay in the processing of the application requested by applicant. However, even assuming *arguendo* that the filing of an RCE is a delay in the processing of the application requested by applicant, the subsequent indication by the USPTO that the application is allowable ends such a delay and causes the application to be “back on track” with respect to typical prosecution in the absence of an RCE. In other words, in the normal course, all applications that are indicated as allowable will have a Notice of Allowance prepared and forwarded to Applicant by the USPTO, whereupon the applicant can pay the appropriate fees and have the application proceed to issuance. As a result, the time period from an indication of allowability by the USPTO and ending on the patent issuance date does not constitute “[a]ny delay in the

processing of the application by the Office that was requested by the applicant,” such that the time period from an indication of allowability by the USPTO and ending on the patent issuance date should not be excluded from calculation of the period of B delay.

Under such an interpretation, the filing of an RCE would cause the period of B delay to include (1) the period of time from one day after the 3-year pendency anniversary and ending on the patent issuance date *minus* (2) the period of time from the filing of the RCE and until the indication of allowability by the USPTO (as opposed to ending on the patent issuance date). In other words, the period of B delay would stop with the filing of an RCE by an applicant but would start again with the indication of allowability by the USPTO because the application is “back on track.”

With respect to the patent application underlying the referenced patent, a first RCE was filed on December 2, 2004, and a second RCE was filed on September 23, 2010. The USPTO mailed a first Notice of Allowance to Applicants on July 27, 2009, and a second Notice of Allowance to Applicants on July 25, 2011. Thus, even assuming *arguendo* that the filing of an RCE is a delay in the processing of the application requested by applicant, Applicants respectfully submit that the B delay calculation should be adjusted to include the period of time from one day after the 3-year pendency anniversary (i.e., from June 9, 2003) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 3103 days] *minus* the period of time from the filing of the first RCE (i.e., from December 2, 2004) until the mailing of the first Notice of Allowance (i.e., until July 27, 2009) [which is a time period of 1699 days] and the period of time from the filing of the second RCE (i.e., from September 23, 2010) until the mailing of the second Notice of Allowance (i.e., until July 25, 2011) [which is a time period of 306 days], which would result in a 556 day increase in the period of B delay (i.e., an increase in the period of B delay to account for the period of time from the day after the date of the mailing of the Notice of Allowance on July 27, 2009 through the filing of the second RCE on September 23, 2010 and from the day after the date of the mailing of the Notice of Allowance on July 25, 2011 through the December 6, 2011 patent issue date).

Alternatively, Applicants respectfully submit that the B delay calculation should be adjusted to include the period of time from one day after the 3-year pendency anniversary

(i.e., from June 9, 2003) and ending on the patent issuance date (i.e., to December 6, 2011) [which is a time period of 3103 days] *minus* the period of time from the filing of the first RCE (i.e., from December 2, 2004) until the mailing of the second Notice of Allowance (i.e., until July 25, 2011) [which is a time period of 2427 days], which would result in a 134 day increase in the period of B delay (i.e., an increase in the period of B delay to account for the period of time from the day after the date of the mailing of the Notice of Allowance on July 25, 2011 through the December 6, 2011 patent issue date).

Improper Reduction in B Delay for Appellate Review

In addition to the above, 35 U.S.C. § 154(b)(1)(B) also states that the period of delay due to the failure of the USPTO to issue a patent within 3 years after the actual filing date does not include “any time consumed by appellate review by the Board of Patent Appeals and Interferences.” However, contrary to the provisions of 35 U.S.C. § 154(b)(1)(B), 37 C.F.R. § 1.703(b) indicates that if a Notice of Appeal is filed, and the Examiner subsequently reopens prosecution by the mailing of an Office Action, the period of time from which the Notice of Appeal was filed until the mailing date of the Office Action should be subtracted from the period of patent term adjustment calculated under 37 C.F.R. § 1.702(b). The relevant portion of 37 C.F.R. § 1.703(b) reads as follows:

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, *but not including* the sum of the following periods:

(4) The number of days, if any, in the period beginning on the date *on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title* and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal

under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or *on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.*

37 C.F.R. § 1.703(b) (emphasis added). Thus, while the determination of patent term adjustment is controlled by 35 U.S.C. § 154, which contains an exclusion of *any time consumed by appellate review by the Board of Patent Appeals and Interferences* for purposes of calculating the patent term adjustment, 37 C.F.R. § 1.703(b) reduces the patent term adjustment period under 35 U.S.C. § 154(b)(1)(B) by the time period from which a Notice of Appeal was filed until the subsequent mailing of an Office Action.

During the prosecution of the application underlying the referenced patent, a Notice of Appeal was filed on February 12, 2003. The USPTO subsequently mailed an Office Action on June 3, 2003, thereby reopening prosecution. As such, the prosecution of the application underlying the referenced patent *did not* include any time consumed by appellate review by the Board of Patent Appeals and Interferences.

The USPTO's patent term adjustment calculation includes a reduction in the period of B delay of 112 days for the period beginning on February 12, 2003, the date on which a Notice of Appeal was filed, and ending on June 3, 2003, the date of mailing of an action under 35 U.S.C. 132. As discussed above, since the USPTO reopened prosecution of the '288 application after the Notice of Appeal was filed, the filing of the Notice of Appeal did not result in appellate review by the Board of Patent Appeals and Interferences. Thus, the USPTO's current patent term adjustment calculation improperly penalizes Applicants for a period of time (i.e., 112 days) that was not consumed by appellate review by the Board of Patent Appeals and Interferences.

The USPTO implicitly acknowledged that the current method of calculating the period of appellate review is improper by issuing a Notice of Proposed Rule Making on December 28, 2011, in which the USPTO proposes to change the rules of practice to indicate that the period of appellate review under the patent term adjustment provisions of 35 U.S.C. §

154(b)(1)(B) begins when jurisdiction over the application passes to the Board of Patent Appeals and Interferences (BPAI), rather than the date on which a Notice of Appeal to the BPAI is filed. Proposed Rules, 76 Fed. Reg. 81432, 81437 (Dec. 28, 2011). The Notice of Proposed Rule Making states, *inter alia*, that the USPTO is proposing to amend 37 C.F.R. § 1.703(b)(4) to define the period of delay “as the sum of the number of days, if any, in the period beginning on the date on which jurisdiction over the application passes to the BPAI under § 41.35 of this title and ending on the date of a final decision in favor of the applicant by the BPAI or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.” Proposed Rules, 76 Fed. Reg. at 81435.

Under the USPTO’s proposed new rule, the period of delay calculated under 37 C.F.R. § 1.703(b)(4) for the referenced patent would be 0 days because the filing of the Notice of Appeal did not result in jurisdiction over the application passing to the BPAI. Accordingly, the patent term adjustment calculation for the referenced patent would not include a reduction in the period of B delay of 112 days, thereby increasing the period of B delay by 112 days.

Conclusion

In view of the foregoing, Applicants request that the USPTO reconsider and correct the period of B delay to include the period from June 9, 2003, the day after the date that is three years after the date on which the ‘288 application was filed, through December 6, 2011, the date the referenced patent issued, which constitutes a total of 3103 days, but not including the period from August 15, 2006, the date an interference was declared to involve the ‘288 application, through September 15, 2008, the date that the USPTO has calculated as the termination date of the interference involving the ‘288 application, which constitutes a total of 763 days. Thus, the correct period of B delay is 2340 days (i.e., 3103 days - 763 days), and the correct total patent term adjustment is 2654 days. Specifically, the correct total patent term adjustment represents the combination of (1) the examination delay of 1890 days by the USPTO under 37 C.F.R. §§ 1.702(a) and 1.703(a), (2) the examination delay of 2340 days by the USPTO under 37 C.F.R. §§ 1.702(b) and 1.703(b), (3) the examination delay of 763 days by the USPTO under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e), minus 1890

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Application for Patent Term Adjustment


overlapping days between the A and B delays and the A and C delays, minus 449 days of Applicant delay under 37 C.F.R. § 1.704 (i.e., $(1890 + 2340 + 763) - 1890 - 449 = 2654$).

Payment of application for patent term adjustment fee (37 C.F.R. § 1.18(e))

- ☒ Please charge Deposit Account No. 12-1216 in the amount of \$200.00.
- ☐ A check in the amount of \$ is enclosed.
- ☒ Charge Account No. 12-1216 for any additional fee required.

The Commissioner is further authorized to charge any extension of time fees pursuant to 37 C.F.R. 1.17(a)-(d) associated with this communication and to credit any excess payment to Deposit Account No. 12-1216.

Respectfully submitted,



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Date: February 6, 2012